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In re Patent No. 6,742,816
Issue Date: June 1, 2004
Application No. 09/764,473
Filed: January 17, 2001
Inventor: Rocheleau

OFFICE OF PETITIONS

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This patented file has come to the attention of this office by way of the communication that apparently was originally entrusted to the mails on or about February 17, 2004, and resubmitted July 8, 2005, which is being treated as a petition under 37 CFR 1.181(no fee) requesting that former counsel of record be reinstated as counsel of record. The USPTO sincerely regrets the delay in treating this petition.

The petition is granted.

The unfortunately favorable treatment by the USPTO on February 9, 2004, of the request for revocation and power of attorney to Barry G. Magidoff, Paul Sutton, Claude Narcisse, and Eli Weiss, (collectively, "Magidoff") filed by or on behalf of Taco, Inc. ("Taco") on December 11, 2003, is **vacated as granted in error**.

The power of attorney is restored to Michael Persson, sole. The "power" given to Magidoff by Taco has been revoked and all improperly recognized counsel have been removed from the list of counsel of record herein. The correspondence address was previously changed to that given above. The USPTO error is regretted. On a one time basis only, a courtesy copy of this decision is being sent to Taco via Magidoff. The USPTO will not undertake dual correspondence.

Petitioner requests that Mr. Persson be reinstated as attorney of record in that the named inventor has never executed an assignment of this application to Taco. Therefore, petitioner asserts, there is no assignee who could intervene and any such intervention was defective and should not have caused a revocation of the power previously granted to Persson. Unfortunately, the original petition has not been found in the file and cannot be located. It is noted that the USPTO correspondence address records show that the correspondence address was changed from that associated with Magidoff to that given above on June 23, 2004.

Inspection of the record reveals that Mr. John Rocheleau, the sole named inventor, appointed Michael Persson as his sole registered representative in the combined declaration and power of attorney filed January 17, 2001. Accordingly, Rocheleau is presumed, in the absence of an assignment, to be the owner of this application. See 37 CFR 3.73(a). There is nothing in the record of this file, or in the assignment records of the USPTO showing that Persson has subsequently conveyed his right title and interest in this patent to any other party, including

either Becca Tooools, Inc., ("Becca") or Taco. Accordingly Rocheleau retains his right to appoint and revoke a power of attorney, and his power to Persson should stand unrevoked.

Under 37 CFR 3.73, the assignee of the entire interest may prosecute an application to the exclusion of the named inventor, or any previous assignee, and also revoke, or appoint, a power of attorney in the application or patent. This, however is contingent upon the putative assignee establishing its ownership of the application to the satisfaction of the Director. See 37 CFR 3.73(b). Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., a copy of an executed assignment submitted for recording) or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office. Id. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Id.; see also MPEP 324. Inspection of the submission filed December 11, 2003 by Magidoff on behalf of Taco reveals that it facially lacks compliance with foregoing requirements of the regulation. As such, it was error for the USPTO to have accepted that Taco was the assignee of the entire interest much less changed the correspondence address and recognized the power to Magidoff.

A review of the assignment records of the USPTO indicates that the same 34 pages of documents have been twice recorded against the instant application at reel 14152, frames 276 and 359, which purport to show a chain of title from Rocheleau to Becca and from Becca to Taco. While the documents were recorded against this application by Magidoff as "assignments", such recordation as an "assignment" was simply predicated upon the assertions made on the assignment recordation cover sheet tendered and executed by Magidoff pursuant to 37 CFR 3.31. However, as set forth in 37 CFR 3.54, and MPEP 317.03, the recordation of a document proffered as an "assignment" is **not** a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent. As further noted by the foregoing authorities, when, as here, it becomes necessary, the USPTO will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office. See also MPEP 324.

Inspection of the copy of the the most relevant of the recorded documents, which is captioned as "Exclusive License and Option Agreement" ("Agreement") pursuant to 37 CFR 3.54 reveals that the Agreement is clearly self-styled (at frames 277 and 362) as a "License" Agreement. It is well settled that a license is merely a promise by the licensor [Becca] not to sue the licensee [Taco] for infringement, and, as such, title to the case does not change hands. Spindelfabrik Suessen-Schurr v. Schubert & Salzer, 829 F.2d. 1075, 1081, 4 USPQ2d 1044, 1048 (Fed. Cir. 1987), *cert. denied*, 116 S.Ct. 274 (1995). This characterization is reinforced by the express reservation clauses at paragraphs 6.1 and 6.2 (recorded at reel 14152 frames 282 and 365) wherein Becca (Rocheleau here acting as president of Becca) expressly retained legal title to the application and the sole right to initiate suit for infringement, and did not transfer any right, title, or interest to Taco. Thus, while there is no evidence of record at the USPTO that Rocheleau ever conveyed his right title and interest herein to Becca, the record is further conspicuously absent of any evidence that either Rocheleau or Becca manifested any intent whatsoever to further convey any interest to Taco. Thus, even if the submission filed December 11, 2003, by Magidoff on behalf of Taco had contended that the chain of title from Rocheleau [to Becca] to Taco was evidenced by the documents recorded at reel 14152 frames 276 *et seq.* and 359 *et seq.*, the recorded documents themselves would not have established

that Taco was the assignee of the entire interest, such that Taco could appoint and/or revoke a power of attorney, much less change the correspondence address.

This patent file is being returned to the Files Repository.

Inquiries related to this decision should be directed to the undersigned at (571) 272-3217.



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cc:

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